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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/714,133

11/14/2003

Tsuyoshi Ohyama

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06/05/2008

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EXAMINER

SCHLICHTER, ANDREW M

ART UNIT

PAPER NUMBER

2871

MAIL DATE

DELIVERY MODE

06/05/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/714,133

Applicant(s)

OHYAMA ET AL.

Examiner

ANDREW SCHECHTER

Art Unit

2871

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-10, 18-20 and 23-45 is/are pending in the application.
4a) Of the above claim(s) 8-10 and 23-45 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 18-20 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 27 February 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Request for Continued Examination

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11 March 2008 has been entered.

Response to Arguments

2. Applicant's arguments filed 11 March 2008 have been fully considered but they are not persuasive.

The applicants argue that *Roosendaal* is not a proper reference under 35 USC 102 due to the submission of the affidavit of 11 March 2008. This is not persuasive.

As a preliminary matter, there has been some confusion over the date of abandonment of the Japanese Application No. 2002-049163 (JP '163), of which Japanese Application 2002-333364 (JP '364) is a continuation, with JP '364 serving as the foreign priority document for this US application. In the affidavit of 16 August 2007, section 9, it was stated that "JP '163 was abandoned at the time of filing the JP '364 application." The examiner interpreted this to mean that its status was "abandoned" at the time of filing [as stated on p. 3 of the office action of 6 September 2007, that JP '163

was "abandoned prior to the filing of the JP '364 application"], but it appears that the statement was intended to mean instead that the action of abandoning the application took place around the time when JP '364 was filed. In the affidavit of 11 March 2008, section 8, it is stated that "JP '163 was pending at the time of filing the JP '364 application" and the applicant argues [p. 7] that the examiner's statement of 6 September 2007 is incorrect. So, although the date of abandonment of JP '163 is not known, it is now established by this affidavit that JP '163 was indeed still pending when the continuation JP '364 was filed on 18 November 2002, and JP '163 was presumably abandoned on or after this date.

Now, regarding the main question: in order to overcome the *Roosendaal* reference, the affidavit must establish two things in this case [see MPEP 715, for instance]. First, it must show facts to establish conception of invention prior to the effective date of the reference, and second, it must show facts to establish due diligence from prior to the said date to a subsequent reduction to practice or to the filing of the application. The examiner agrees that the affidavit evidences conception of the invention at least as early as 26 February 2002, thus fulfilling the first requirement.

However, the second requirement requires a showing of diligence from prior to the effective date of the reference (26 August 2002) to a subsequent reduction to practice or to the filing of the application. This has not been done.

The affidavit states in sections 22-23 that the applicants filed and actively prosecuted the JP '163 and JP '364 applications in Japan. This is not sufficient to show the required diligence. JP '364 was filed on 18 November 2002 and prosecuted

thereafter; therefore these actions do not evidence diligence between 26 August 2002 and 18 November 2002 (the preparation of JP '364 is discussed below). JP '163 is the parent of JP '364, and as such its active prosecution is not considered evidence of diligence toward the filing of the present US application. [To see why not, consider that if it were, it would undermine the 12 month requirement for benefit of foreign priority under 35 USC 119. There would be no need to file a US application within 12 months of the foreign filing, since active prosecution of a series of foreign continuations would automatically prove conception and diligence to a remote date in the past, thus antedating potential 102(e) references even if they were filed several years outside the 12 month window. This is clearly an absurd result, therefore it cannot be that the active prosecution of the parent of a foreign application provides evidence of diligence toward the filing of a US application which relies on the foreign application as its priority document. Rephrasing: to obtain benefit of filing a foreign application, an applicant must file the US application within 12 months to obtain the benefit under 35 USC 119; it would completely circumvent this requirement to be able to file a continuation of the foreign application, rely on the continuation for the foreign priority of the US application, and then have the time period of prosecuting the original foreign application be automatically considered as a period of diligence towards the US filing.]

The affidavit states in section 24 that the applicants assert there was reasonable diligence in the relevant time period. Such mere assertions are not considered evidence of diligence, which requires a showing of facts.

The affidavit states in section 25 that "the time period taken for completion of the application for foreign filing constitutes reasonable diligence" and states that "[d]uring this time period, we and our representatives worked reasonably hard and expeditiously to prepare, execute, and file an application in Japan." In the opinion of the examiner, this is not a sufficient showing of facts. The "time period" in question, which was not stated explicitly by the applicant, is from 26 August 2002 to 18 November 2002, almost three months. The statement that they "worked reasonably hard and expeditiously to prepare, execute, and file an application in Japan" does not specify which application, and it does not evidence any dates of particular activities by particular individuals. Furthermore, as the JP '364 application is a continuation of the JP '163 application with a similar specification to that previously filed application, it is not apparent why three months would be required to expeditiously prepare and file the JP '364 application. It may be possible for the applicant to evidence such "attorney-diligence" during this time period, but the entire time period must be accounted for and diligence requires that the applicants be specific as to dates and facts [see MPEP 2138.06]. This has not been done.

The affidavit filed 11 March 2008 is therefore insufficient to establish diligence, so *Roosendaal* remains a proper reference and the previous rejections are repeated below.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Roosendaal et al.*, U.S. Patent No. 6,731,360.

Roosendaal discloses [see Fig. 1, for instance] a method of manufacturing a liquid crystal display which has a pair of substrates [inherent] and a liquid crystal layer [12] interposed between the substrates and which has a reflective area [on left] and a transmissive area [on right], the method comprising the steps of forming a retardation film [16a] on at least one of the substrates, and patterning the retardation film such that the retardation film remains at least in the reflective area and the phase difference of the retardation film differs between the reflective area and the transmissive area [col. 5, lines 22-26, etc.]. *Roosendaal* does not (perhaps) explicitly disclose that an alignment film is formed on at least one of the substrates and the retardation film is formed on the alignment film.

However, *Roosendaal* does disclose manufacturing the patterned quarterwave foil by photo-polymerization of a reactive liquid crystal material, and states that "[these] materials get their orientation from thin polymer alignment films; similar to those used to orientate a liquid crystal layer" [col. 6, lines 4-8]. It would therefore have been obvious to one of ordinary skill in the art at the time of the invention to form an alignment layer

between the substrate and the retardation film in *Roosendaal*, motivated by *Roosendaal*'s teaching that this is the means by which the retardation film gets its orientation. Claim 18 is therefore unpatentable.

The retardation film is composed of a liquid crystal polymer [col. 6, lines 4-8], so claim 19 is also unpatentable.

5. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Roosendaal et al.*, U.S. Patent No. 6,731,360 in view of *Kubota et al.*, U.S. Patent No. 6,771,334 and *Kitagawa et al.*, U.S. Patent No. 6,404,469.

Roosendaal does not disclose that the liquid crystal polymer is obtained by curing an ultraviolet-curable liquid crystal monomer in a nematic phase. *Kubota* discloses an analogous device and teaches that the retardation film with differing regions can be obtained by curing a "UV crosslinking liquid crystal polymer" [col. 10, lines 34-40]. *Kubota* is silent on the nematic phase limitation; *Kitagawa* discloses such a compensator in a nematic phase [col. 3, lines 6-17]. It would have been obvious to one of ordinary skill in the art at the time of the invention to make the retardation layer a liquid crystal polymer of such a composition (UV curable material) in a nematic phase, motivated by *Kitagawa*'s teaching that the production process for such sheets is known and they are commercially available (reducing uncertainties and experimentation in manufacturing), and *Kubota*'s and *Kitagawa*'s teaching that they allow control of optical characteristics including retardation. Claim 20 is therefore unpatentable.

Election/Restrictions

6. Claims 8-10 and 23-45 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made without traverse in the reply filed on 4 August 2005.

Conclusion

7. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Schechter whose telephone number is (571) 272-2302. The examiner can normally be reached on Monday - Friday, 9:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Nelms can be reached on (571) 272-1787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andrew Schechter/
Primary Examiner, Art Unit 2871
Technology Center 2800
3 June 2008